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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,519	11/14/2003	Robert E. Platt	1522-K-CONT	9978
27542	7590	09/22/2005	EXAMINER	
SAND & SEBOLT AEGIS TOWER, SUITE 1100 4940 MUNSON STREET, NW CANTON, OH 44718-3615			MACARTHUR, VICTOR L	
			ART UNIT	PAPER NUMBER
			3679	

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/713,519

Applicant(s)

PLATT, ROBERT E.

Examiner

Victor MacArthur

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3,4 and 15-18 is/are allowed.
- 6) ☒ Claim(s) 1,2,5-14,19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

The drawings were received on 7/8/2005. These drawings are acceptable for the purposes of examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 2, 5-14, 19 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Claim 1 contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Specification and Drawings do not support the claim 1 limitations “the rear wall of the rail connector is slidingly movable along the outer wall of the bracket” (lines 7-8 of claim 1) and “a second connector mechanism fixedly connecting the rail connector to the bracket” **at the same time** (emphasis added). In other words it appears that at the time the invention was filed the inventor(s) did not have possession of an invention comprising a bracket and rail connector that were both “slidingly movable” and “fixed” to one another **at the same time** (emphasis added). Claim 6 is similarly rejected. Claims 2, 5, 7-14, 19 and 20 ultimately depend from either claim 1 or 6 and thus are similarly rejected. The examiner notes that the applicant has attempted to amend to overcome this rejection. However, claim 1 and newly

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independent claim 6 positively recite both the condition of “the rear wall of the rail connector is slidably movable along the outer wall” and the condition of “a second connector mechanism fixedly connecting the rail connector to the bracket”. The applicant is reminded that claim 1 is a product claim, not a method of using or method of making. As such the applicant cannot positively claim the invention in two separate states of assembly at the same time (i.e., both before and after the second connector mechanism is installed). The applicant should amend claims 1 and 6 in a manner similar to claim 3 wherein the second connector mechanism is merely intended “to fixedly connect” rather than positively fixedly connecting. Alternatively, claims 1 and 6 could be amended in a manner similar to the functional/conditional language used by the examiner to reject claim 1 under 35 USC § 102 below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 5 and 7-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Francis (U.S. Patent 4,767,232).

Claim 1. Francis discloses (figs.2-4) a rail clip for attaching a rail to a post, the rail clip comprising: a bracket (20) adapted to be mounted on the post (10), the bracket having an outer wall (wall of 20 contacting 22) a rail connector (22) having a rear wall (wall of 22 contacting 20) which lies in abutting contact with the outer wall of the bracket; a first connector mechanism

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(84) disposed on the rail connector and bracket that interlocks the rail connector and bracket together; whereby the rear wall of the rail connector is slidably movable (during rotation) along the outer wall of the bracket to allow the rail connector to be placed at a desired position on the outer wall of the bracket; and a second connector mechanism (80) that is capable of fixedly connecting (via tightening to a point where rotation is prohibited) the rail connector to the bracket once the rail connector is disposed at a desired position on the outer wall of the bracket.

Claim 2. Francis discloses that the outer wall of the bracket is arcuate and the rail connector slidably engages the outer wall of the bracket and wherein the position of the rail connector is adjusted by sliding the rail connector along the outer wall of the bracket.

Claim 5. Francis discloses that the rear wall of the rail connector is complementary shaped to the outer wall of the bracket; and wherein the rail connector further comprises a peripheral wall (wall of 22 receiving 80) extending forwardly and outwardly away from the rear wall of the rail connector; the peripheral wall defining an interior cavity therein (cavity of 22 receiving 80), the cavity being adapted to receive (but not necessarily receiving) an end of a rail therein (i.e. a rail that has a smaller diameter than the cavity).

Claim 7. Francis discloses that a portion of the peripheral wall (wall of 22 receiving 80) includes side walls (side walls of cavity in 22 receiving 80) each having an interior face (interior face of 22 receiving 80) adapted to abut a rail (i.e. a rail smaller than the cavity) received within the interior cavity of the peripheral wall, an exterior face (exterior face of 22) and front and back edges (front and back edges of 22) wherein the front edges of the side walls lie remote from the bracket when the rail connector and bracket are engaged together, and wherein each of the side walls extends a short distance rearwardly beyond the rear wall of the rail connector thereby

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forming a lip (lip of 22 receiving tip of 20) between the back edge of each side wall and the rear wall of the rail connector; and wherein the lips abut an outer surface of the bracket.

Claim 8. Francis discloses that the back edges of the side walls are concave in shape.

Claim 9. Francis discloses that the back edge of the side walls is adapted to be complementary shaped with the outer wall of the bracket (in that it fits within).

Claim 10. Francis discloses that the lip further includes a ridge (edge of cavity in 22 receiving 80), the ridge running along the back edge of the side wall.

Claim 11. Francis discloses that the bracket (20) defines a first groove (groove receiving 84) and the ridge of the rail connector (22) interlocks (via 84 and 80) with the first groove so as to connect the rail connector and bracket together while allowing sliding (rotational sliding) engagement between the bracket and rail connector; the ridge and the first groove comprising the first mechanism for securing the bracket and the rail connector together.

Claim 12. Francis discloses that the bracket has a rear wall (23) and the rear wall is substantially flat and is adapted to abut a substantially flat wall on the post.

Claim 13. Francis discloses that the second connector mechanism extends through the rear wall of the rail connector and into the outer wall of the bracket.

Claim 14. Francis discloses that the second connector mechanism is a screw.

Allowable Subject Matter

Claims 3, 4 and 15-18 are allowed for reasons stated in a previous Office Action.

Claim 6 would be allowable, as stated in a previous Office Action, if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 1st paragraph, set forth in this Office action. Claims 19 and 20 depend from claim 6 and as such would similarly be allowable.

Response to Arguments

Applicant's arguments with regard to the claim rejections have been fully considered but they are not persuasive.

The applicant argues that the 35 USC § 112 rejection has been overcome by amendment. This is not persuasive as is detailed in the further clarified 35 USC § 112 rejection above.

The applicant argues that elements (80) and (84) of Francis are not two connector mechanisms since if either of them were omitted the Francis joint would be inoperable whereas the applicant's first connector mechanism would hold the applicant's invention together even if the second mechanism were omitted. This is not persuasive since no recitation of operability in the absence of the second connector mechanism is positively recited in the claims. Elements (80) and (84) are two connector mechanisms since they are two mechanisms which connect, within the broadest reasonable interpretation of the claim language.

The applicant argues that the cavity in joint member (22) of Francis is intended to receive pivot pin (80) therein rather than a rail. This is not persuasive since the applicant's claims do not recite any limitation specifically prohibiting receipt of a pivot pin in the cavity. Furthermore, the limitation "adapted to receive" a rail therein is met by Francis since the Francis cavity presents an open space fully capable of receiving a rail of small dimension. The fact that Francis does not positively disclose a rail received within a cavity but merely shows a cavity that is structurally

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capable of (and thus adapted to) receiving a rail is irrelevant since the applicant's claims do not positively recite that a rail is positively received in the cavity. It is well established that a recitation with respect to the manner in which an apparatus is intended to be employed (*i.e.* a functional limitation such as "adapted") is given only limited patentable weight since it does not impose any structural limitation upon the claimed apparatus which differentiates it from a prior art reference disclosing the structural limitations of the claim. In re Pearson, 494 F.2d 1399, 181 USPQ 641 (CCPA 1974); In re Casey, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); In re Otto, 312 F.2d 937, 136 USPQ 458 (CCPA 1963).

The applicant argues that Francis does not disclose the "peripheral wall" of claim 7. This is not persuasive. Francis discloses a peripheral wall (wall of 22 receiving 80).

The applicant argues that Francis does not disclose "various component features" but fails to specify precisely what claimed features are not disclosed. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (571) 272-7085. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-3600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.



VLM

September 9, 2005



DANIEL P. STODOLA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600



Acceptable
Jm
9/9/05

REPLACEMENT SHEET

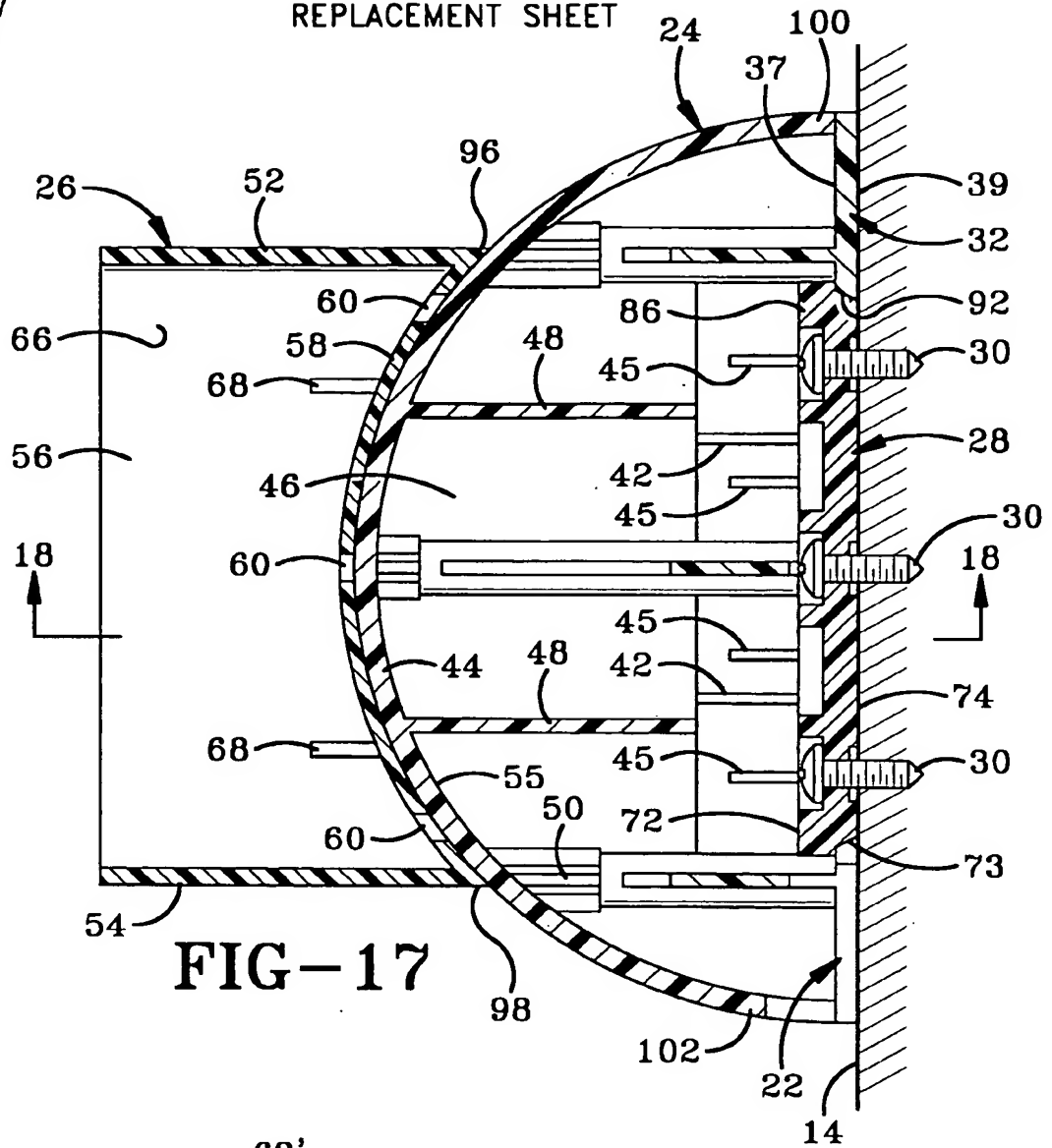


FIG-17

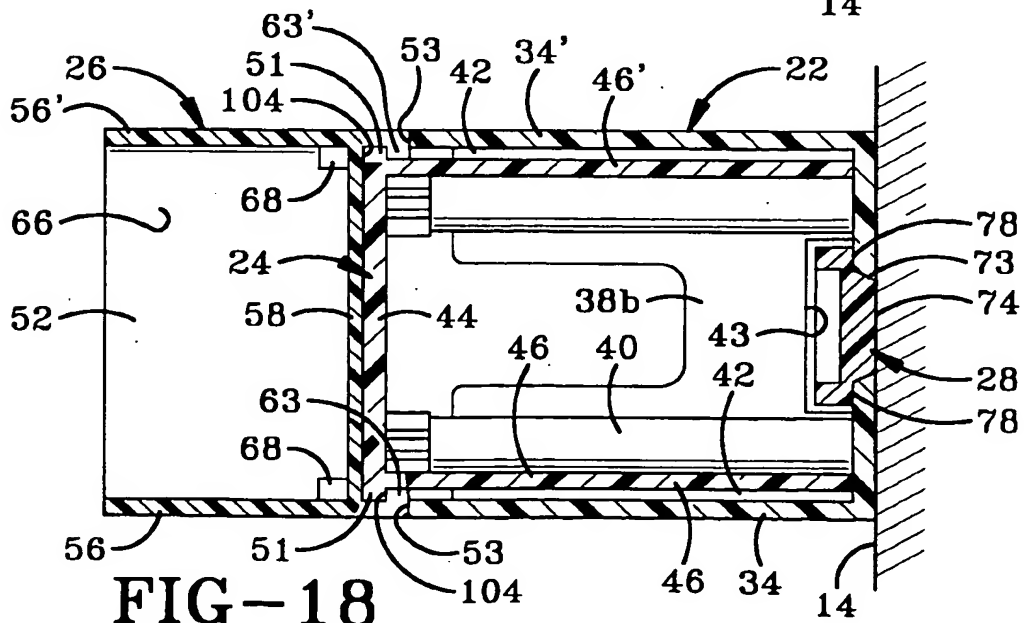


FIG-18